



AS

IN THE UNITED STATES

PATENT AND TRADEMARK OFFICE

RECEIVED

APPLICANT(S): Stephen A. Morse, et al.

JUN 03 2004

APPLICATION NO.: 10/001,416

OFFICE OF PETITIONS

FILING DATE: November 15, 2001

TITLE: Orbital Surgical Cannula and Method

EXAMINER: Michael H. Thaler

GROUP ART UNIT: 3731

ATTY. DKT. NO.: 80121-06507

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Reissue, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below:

Dated: 5/25/04

By: A.C. Smith

Albert C. Smith, Reg. No. 20,355

MAIL STOP REISSUE
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

06/17/2004 CKHLOK 00000013 192555 10001416

01 FC:1051 130.00 DA RESPONSE REGARDING REISSUE DECLARATION
AND PETITION UNDER 37 C.F.R. §1.47(a)

SIR:

Responsive to the Official Action dated November 28, 2003, received in the patent application identified above, applicants are submitting herewith:

a Combined Declaration and Power of Attorney signed by inventors Stephen A. Morse, Peter L. Callas, Andrew G.C. Frazier, Albert K. Chin;

06/01/2004 KMEKONEN 00000087 10001416

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130.00 OP

PATENT

- a Declaration of Facts by Albert C. Smith in Support of this Petition , with Exhibits A-B;
- payment in the amount of \$1,080 for the
 - fee for a three (3) month extension of time; and
 - petition fee under 37 CFR §1.17(i)
- The last known address of Geoffrey A. Orth is:

Geoffrey A. Orth
9145 St. James Place
Windsor, CA 95492

Respectfully submitted,
STEPHEN A. MORSE, ET AL.

Dated: 5/25/04

By: A. C. Smith
Albert C. Smith, Reg. No.: 20,355
Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Tel.: (650) 335-7296
Fax.: (650) 938-5200



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Dated: 5/25/04

By: Albert C. Smith

Albert C. Smith, Reg. No. 20,355

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COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

**DECLARATION OF FACTS BY ALBERT C. SMITH
IN SUPPORT OF PETITION UNDER 37 C.F.R. §1.47(a)**

SIR:

This Declaration of Facts is made regarding the facts that are relied upon to show the diligent effort that was made to secure the execution of the Combined Declaration and Power of Attorney for the above-identified Reissue Patent

Application by omitted inventor Geoffrey A. Orth (hereinafter "Mr. Orth"), for the above-referenced reissue patent application after receipt of the official action dated November 28, 2003.

This Declaration of Facts is being made by the undersigned attorney of record having first-hand knowledge or information and belief of the facts recited therein.

1. I am a patent attorney licensed to practice before the U.S. Patent and Trademark Office, Reg. No. 20,355.
2. I am a partner of Fenwick & West LLP, a law firm having offices 801 California Street, Mountain View, California 94041.
3. On November 15, 2001, I filed an application for reissue of US. Patent No. 5,984,937 that issued on November 19, 1999 at the request of the client and patent owner of record, Origin Medsystems, Inc., having offices in Menlo Park and Santa Clara, California (hereinafter "Origin").
4. The reissue application names five inventors: Stephen A. Morse, Peter L. Callas, Andrew G.C. Frazier, Albert K. Chin, Geoffrey A. Orth.

5. I filed the reissue application with a Reissue Application Declaration by the Assignee on behalf of the patent owner, Origin.

6. On November 28, 2003, the U.S. Patent and Trademark Office mailed an official action for the above-referenced patent application indicating a defective Reissue Declaration for lack of inventors' signatures.

7. Upon information and belief, each of the named inventors was at one time employed by or worked on projects for Origin.

8. Upon information and belief formed through communications with various employees of Origin, I learned that some of the inventors were no longer associated with or employed by Origin, and I was requested to contact the named inventors directly at their respective addresses as last known to Origin.

9. On May 4, 2004, I sent a package via first class mail to Geoffrey A. Orth at 9145 St. James Place, Windsor, CA 95492, containing copies of the reissue application and Reissue Declaration as well as a cover letter asking Mr. Orth to review and, if acceptable, to sign and return the documents in the return-addressed, pre-paid mailer that was provided. A true copy of the cover letter is attached as Exhibit A.

10. The entire package as sent was returned as not being deliverable at the designated address, and not forwardable. A true copy of the returned package is attached as Exhibit B.

11. On May 21, 2004, I telephoned Mr. Orth at the telephone number (1-707-823-0223) for Mr. Orth last known to Origin, and was informed by recorded message that the telephone had been disconnected.

12. As of the date hereof, I have not received any responses from Mr. Orth regarding the reissue application and Reissue Declaration, nor any additional information concerning his whereabouts or further contact information.

I hereby declare that all statements made herein to the best of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Code, and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,
STEPHEN A. MORSE, ET AL.

Dated: 5/25/04

By: A.C. Smith
Albert C. Smith, Reg. No.: 20,355
Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Tel.: (650) 335-7296
Fax.: (650) 938-5200



FENWICK & WEST LLP

EXHIBIT A

May 4, 2004

Geoffrey A. Orth
9145 St. James Place
Windsor, CA 95492

RE: U.S. Reissue Application Serial No.: 10/001,416
Title: Orbital Dissection Cannula and
Method
Filed: November 15, 2001
Inventor: Stephen A. Morse, Peter L. Callas,
Geoffrey A. Orth, Andrew G.C.
Frazier, Albert K. Chin
Our Ref.: 80121-06507
Your Ref.: R0045RE

Dear Geoffrey:

Enclosed is a Reissue Declaration by the Inventors for the above-referenced application for which you are a named Inventor. If all is in order and acceptable, then please execute this Declaration where indicated and return the executed copy to us as soon as possible using the postage-paid envelope that is enclosed.

Please contact me at (650) 335-7296 if you have any questions or comments regarding this declaration or this application to date.

Sincerely,
FENWICK & WEST LLP

Al Smith

Albert C. Smith

ACS/dkc

Enclosure: Reissue Declaration by the Inventors
Copy of application

Silicon Valley Center
801 California Street
Mountain View, CA 94041

Tel 650.988.8500
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www.fenwick.com

Silicon Valley • San Francisco

80121/06507/DOCS/1432875.1

NO11H16101789


\$0 1290

05/04/2004
Nailed From 94041
00096112

Hassler

EXHIBIT B



Not Deliverable as Addressed
Unable to Forward

Insufficient Address

Moved, Left No Address

Undeliverable

Attempted - Not Known

No Such Street

Number

Vacant

No Mail at Address

Route # 5
Address: CA 125-402-0000



FENWICK & WEST LLP

Silicon Valley Center
801 California Street
Mountain View, CA 94031

RE TURNED
TO ADDRESS
NOT DELIVERABLE
AS ADDRESS
MOVED, LEFT NO ADDRESS
NO MAIL AT ADDRESS
NO SUCH STREET
NUMBER
VACANT
ROUTE # 5
ADDRESS: CA 125-402-0000

Geoffrey A.
9145 St. James Place
Windsor, CA 95492-10 FORWARD

